

REMARKS

Applicants acknowledge receipt of the Office Action dated June 17, 2004, in which the Examiner rejected claims 1, 2, 4, 10, 11, 13 and 19 under 35 U.S.C. § 103(a) as obvious in view of US 4,174,629 to *Striegler* in combination with US 6,423,802 to *Miller* et al.; rejected claims 3 and 12 as obvious in view of the combination of *Striegler* and *Miller* with an article by Thomas; rejected claims 8 and 17 as obvious in view of the combination of *Striegler* and *Miller* with *Clapperton* et al; rejected claims 9 and 18 as obvious in view of the combination of *Striegler* and *Miller* with *Collee* et al; and indicated that claims 5, 6, 6, 14, 15, and 16 would be allowable if rewritten in independent form. Applicants have amended the claims and respectfully traverse these rejections for the reasons set out below.

§ 103(a) Rejections

Claims 1, 2, 4, 10, 11, 13 and 19 stand rejected as allegedly obvious over *Striegler* and *Miller* in combination with various references. Applicants respectfully submit that, in making this rejection, the Examiner has fallen into the common trap of applying Applicant's own teachings in assessing the obviousness of an invention, contrary to the Federal Circuit's recent rigorous circumscription of obviousness rejections.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Winner Intern. Royalty Corp. v. Wong*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Applicants respectfully suggest that the Examiner has failed to establish the requisite motivation to combine the cited references. As detailed below, the Federal Circuit requires the PTO to strictly comply with the motivation to combine requirement.

In *In re Dembiczak*, (Fed. Cir. April 28, 1999), the Federal Circuit reversed the PTO's obviousness rejection of certain claims because the PTO failed to provide a sufficient suggestion to support the proposed combination. The Federal Circuit noted that references cannot be combined unless supported by a sufficient teaching, motivation or suggestion in the art to prevent the "subtle but powerful attraction of a hindsight-based obviousness analysis." *Id.* at 4. The Court expounded on the importance of not analyzing the obviousness of claims using an Applicant's disclosure in hindsight and noted that the § 103 phrase "at the time the invention was made" guards against the "tempting but forbidden zone of hindsight." *Id.* at 4. The Court then reversed the PTO's rejection because the PTO "fell into the hindsight trap" by failing to "particularly identify any suggestion,

teaching, or motivation to combine the [prior] art references....” *Id.* at 4-5 More particularly, the Federal Circuit wrote:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 UPSQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Id.

Extensive case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Applicants submit that it is only through hindsight that the Examiner can assemble the present obviousness rejections.

In fact, *Striegler* expressly teaches away from the use of non-hydrocarbon tracers. At column 1, lines 35-49, *Striegler* states:

When a core is analyzed, it is important to know if the oil in the core has been significantly invaded by filtrate oil from the drilling fluid. It is standard practice to use a tracer chemical in a drilling fluid when it is important that drilling fluid invasion be determined. Tracer materials must be tested to determine their effects on drilling fluids and chemicals, their reaction with gases, their purity, their absorption characteristics on the filter cake or in the formation, solubility, and effects on drilling equipment and related facilities. Tracer materials are costly and frequently hazardous to drilling and core handling personnel. Moreover, the well that is being cored may be in a remote area. The drawbacks of tracer materials and the need for an improved system for detecting appreciable oil filtrate invasion has long existed. (emphasis added).

Thus, one reading *Striegler* would not be motivated to use a tracer material, and certainly would not be motivated to select and use cesium as presently claimed. For all of these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 2, 4, 10, 11, 13 and 19.

Allowable claims

In response to the Examiner’s indication that claims 5, 6, 7, 14, 15, and 16 would be allowable if rewritten, claims 5 and 7 have been placed in independent form. Claims 6 and 14 have

been amended to depend from claim 5 and claims 15 and 16 have been amended to depend from claim 7. The scope encompassed by the claims following these amendments is identical to the scope encompassed by these claims prior to amendment.

New claim 20

Applicants submit herewith a new claim 20, which is identical in scope to allowable claim 5, except that the step of generating a core is modified so as not to require a means for coring. Because the presence of a coring means is not a critical element in the scope of claim 5, Applicants believe that claim 20 is allowable as written for the same reasons that amended claim 5 is allowable.

Conclusion

During the course of these remarks, Applicant has at times referred to particular limitations of the claims that are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and was not an amendment for the purpose of patentability. Further, although Applicant has amended certain claims, Applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

Reconsideration of the newly submitted claims and the allowance thereof is respectfully requested. Applicant invites the Examiner to contact the undersigned to conduct an interview should an interview expedite the resolution of this application.

Respectfully submitted,



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